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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.         | CONFIRMATION NO.       |
|---|-------------|----------------------|-----------------------------|------------------------|
| 10/663,514  | 09/16/2003  | Nolan L. Smith       | 55508-277457                | 5043                   |
| 25764   | 7590        | 07/18/2007           |                             |                        |
| FAEGRE & BENSON LLP<br>PATENT DOCKETING<br>2200 WELLS FARGO CENTER<br>90 SOUTH SEVENTH STREET<br>MINNEAPOLIS, MN 55402-3901 |             |                      | EXAMINER<br>WILLSE, DAVID H |                        |
|   |             |                      | ART UNIT<br>3738            | PAPER NUMBER           |
|   |             |                      | MAIL DATE<br>07/18/2007     | DELIVERY MODE<br>PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/663,514

Applicant(s)

SMITH ET AL.

Examiner

Dave Willse

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on June 25, 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 5-47 is/are pending in the application.
- 4a) Of the above claim(s) 12, 13, 16, 20-24 and 30-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 5-11, 14, 15, 17-19, 25-29 and 34-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 6-4-07.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

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The Applicant has failed to *specifically* point out the support in the original disclosure for each of the newly added limitations to the claims (MPEP §§ 714.02 and 2163.06) and must do so in response to the present Office action.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 34 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. A layer of material coated on the top surface of the lower member as claimed is not found in the original disclosure.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 5, 6, 10, 17-19, 25, 29, 35, 36, 40, 41, and 45-47 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by McCoy, US 4,764,172. In regard to the added

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claim language, the stress distribution over the solid leg prosthesis **12** implies a continuum of support axes throughout the volume of the structure. Moreover, the “leg portion” (claim 1, line 1) is not a positively recited element of the present invention as claimed; the upwardly extending post of McCoy is certainly *capable* of being aligned with a central or some other well-defined longitudinal axis of a leg portion via adaptors or the like, whether or not such was the intent. And standard definitions of the word “alignment” do not necessitate collinearity, so the term “substantial alignment” (instant claim 1, line 5) must be interpreted broadly (MPEP §§ 2111 and 2173.05(b)), particular when read in light of the Applicant’s own Figures 12A and 12B, which depict a pyramidal coupling and thus suggest a range of angulations between the leg portion and the post (sentence bridging pages 7 and 8 of the Applicant’s specification). Regarding claims 6 and 10, the perforation is viewed as the longitudinal or axial hole inherent in the helical form of each coil spring **52** and **58**. Regarding claim 25, heel member **28** is mounted on the bottom of the lower member **18** via screw **26** (column 2, lines 30-32). Regarding claim 29: Figure 4; column 2, lines 25-28.

Claims 1, 5-7, 10, 14, 15, 17-19, 25-29, and 35-47 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Shorter et al., US 5,116,383, which discloses a lower member **12A**, a post **14** threadably engaging an opening in a ball member **46**, and an upper member **44**. The first or anterior buffer corresponds to that part of the resilient rubber ring **54** having the stiffening plates **56** and separated from a second or posterior buffer by medial and lateral buffer portions (Figures 1 and 4; column 4, lines 20-44). The Applicant’s own elected embodiment, represented in Figures 12A and 12B, includes a thin layer **588** integral with both buffers **540** and **542** (Applicant’s specification: page 14, lines 18-22), so the interpretation of the term “separated”

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(instant claim 1, line 10) is deemed to be reasonable under MPEP § 2111. Regarding claims 7 and 10, the perforations receiving the plates **56** extend laterally relative to the longitudinal axes of the foot and the pylon and extend longitudinally relative to the length of the plates **56**. Regarding claims 14 and 15, the plates **56** can be interpreted as plugs in that they fill the aforementioned perforations or slits. Regarding claims 25-28, attention is directed to the heel member **12B** and the heel buffer **28** and **30**. Regarding claim 35 and others, the post can optionally be the shank **46A**.

Claims 8, 9, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shorter et al., US 5,116,383. Regarding claim 8, perforations communicating with slits were well known in the art at the time of the present invention and would have been obvious in order to facilitate insertion of the stiffening plates **56** into the snubber ring **54** or in order to impart a certain level of flexibility to the alternative block of rigid material described at column 4, lines 49-52. Regarding claim 11, a lateral perforation through the second or posterior buffer would have been obvious in order to provide a selection of rings **54** having a diversity of resilient resistances to accommodate a range of amputee preferences and/or activities.

The Applicant's remarks have been considered. With respect to the Shorter et al. patent, the Applicant asserts that the posterior region of the lower member "is where the 'upper and lower keel portions 12A and 12B are joined together at their posterior ends' " (Applicant's reply of May 22, 2007: page 10, lines 2-5). The examiner disagrees, because a posterior *region* is not necessarily confined to a posterior *end*. The anterior-posterior extent of the claimed lower member may consist of (or be defined by) an anterior half or region and a posterior half or region. Other issues are adequately addressed in the grounds of rejection set forth above.

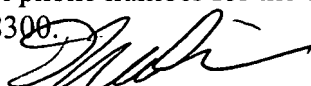
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The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Reference is made to the drawings of Chen, US 2004/0236435 A1, and Tkach, SU 1593652 A1.

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114 (MPEP § 706.07(b)). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse, whose telephone number is 571-272-4762 and who is generally available Monday, Tuesday, and Thursday, and sometimes on Wednesday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



**Dave Willse**  
**Primary Examiner**  
**Art Unit 3738**